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09/901,637	07/11/2001	Tiffany Chen	4504-035	2022

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EXAMINER

SAFAIPOUR, HOUSHANG

ART UNIT

PAPER NUMBER

2627

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/901,637	CHEN ET AL.
	Examiner Houshang Safaipour	Art Unit 2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 September 2005.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-21 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 27, 2005 has been entered.

### ***Specification***

The amendment filed September, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

“the control key configuration file 13 can also be modified easily to change the setting for adjusting the operations of controlling the control keys 41-45 or another specified control key (not shown), saving image file, or/and loading the application program 14”.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claim 1 recites “wherein said control key configuration file is adjustable for recording the procedural steps for each of said plurality of function keys with said application program”.

Since applicant's only argument is that the cited reference does not have such a control key with said application program, the examiner maintains his rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 9-17, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Os et al. (U.S. Patent No. 6,480,304).

Regarding claim 1, Os et al. discloses an apparatus for fast image fetching and processing comprising: a host computer having a buffer, a driver, a control key configuration file, and an application program associated with said control key configuration file; a scanner communicated with said host computer, said scanner having a plurality of function keys and an optical module,

each of said plurality of function keys being operable in response to said control key configuration file, said optical module being controlled in response to said driver for reading an image of a scanned object and converting said scanned image to image data which is saved in said buffer and loaded in an application program associated with said control key configuration file; and an output unit communicated with said host computer for generating the operation result of said application program (fig. 1, col. 2 line 46 through col. 3, line 26).

Regarding claim 2, Os et al. discloses the apparatus as claimed in claim 1, wherein said plurality of function keys comprises a scan function key, and said output unit is a display for viewing the scanned image of said scanned object opened by an image processor (col. 2, lines 46-60).

Regarding claim 3, Os et al. discloses the apparatus as claimed in claim 1, wherein said plurality of function keys comprises a scan function key, and said output unit is a display for viewing the scanned image of said scanned object opened by an editor (col. 2, lines 46-60).

Regarding claim 4, Os et al. discloses the apparatus as claimed in claim 1, wherein said plurality of function keys comprises a print function key, and said output unit is a printer for outputting the scanned image of said scanned object (col. 2, lines 46-60).

Regarding claim 5, Os et al. discloses the apparatus as claimed in claim 1, wherein said plurality of function keys comprises a fax function key, and said output unit is a modulation/demodulation device (MODEM) which is enabled by an application program in response to said fax function key for transmitting the scanned image of said scanned object to a receiver after inputting a fax number of said receiver (col. 3, lines 2-26).

Regarding claim 6, Os et al. discloses the apparatus as claimed in claim 5, wherein said application program further comprises a software keyboard for inputting said fax number (col. 3, lines 2-63).

Regarding claim 7, Os et al. discloses the apparatus as claimed in claim 5, wherein said scanner further comprising: digit buttons for inputting said fax number (col. 3, lines 2-63).

Regarding claim 9, Os et al. discloses the apparatus as claimed in claim 1, wherein said plurality of control keys comprises an Optical Character Recognition (OCR) function key for enabling an OCR application program to convert the scanned image of said scanned object to a text file and display the result on said output unit (col. 3, lines 47-72).

Regarding claim 10, Os et al. discloses the apparatus as claimed in claim 9, wherein said output unit is a display for showing said Optical Character Recognition (OCR) application program and the process result of said scanned image (col. 2, lines 46-60 and col. 3, lines 47-72).

Regarding claim 11, arguments analogous to those presented for claim 1 are applicable to claim 11.

Regarding claim 12, Os et al. discloses the method as claimed in claim 11, wherein said step of defining said control key configuration file comprises the step of: defining a scan function key, an associated driver, an associated application program, an associated program routine to execute said driver and said application program for loading a scanned image (col. 4, lines 31-52).

Regarding claim 13, Os et al. discloses the method as claimed in claim 12, wherein the execution of said control key configuration file comprises the steps of: enabling said driver to

read the scanned image of a scanned object in response to said scan function key; saving said scanned image of said scanned object as an image file; and calling said associated application program to open said image file (col. 4, lines 31-52).

Regarding claim 14, Os et al. discloses the method as claimed in claim 11, wherein said step of defining said control key configuration file comprises the step of: defining a print function key, an associated driver, an associated application program, an associated program routine to execute said driver and said application program for sending a scanned image to a printer (col. 2, line 61 through col. 3, line 1).

Regarding claim 15, Os et al. discloses the method as claimed in claim 14, wherein the execution of said control key configuration file comprises the steps of: enabling said driver to read the scanned image of a scanned object in response to said print function key; saving said scanned image of said scanned object as an image file; and sending said image file to said printer (col. 2, line 61 through col. 3 line 1).

Regarding claims 16 and 17, arguments analogous to those presented for claim 3 are applicable to claims 16 and 17.

Regarding claims 20 and 21, arguments analogous to those presented for claims 9 and 10 are applicable to claims 20 and 21 respectively.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Os et al. (U.S. Patent No. 6,480,304).

Regarding claims 8, 18 and 19, Os et al. discloses a custom button that can be associated with particular software application. If the desired application is not found in user's computer, the user is prompted to specify an application program to associate with the custom button (col. 4, lines 31-52). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to make the custom button an e-mail function key for transmitting the scanned image of scanned object as an attachment file in a new e-mail.

#### *Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipour whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Thurs. from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles, Sr. can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 2622  
October 28, 2005

  
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